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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/721,785

11/26/2003

Hajime Suda

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07/21/2008

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EXAMINER

ZHAO, DAQUAN

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

07/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/721,785 | Applicant(s) SUDA, HAJIME | |
| | Examiner DAQUAN ZHAO | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/26/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to an information recording and playback apparatus which records or plays back information, comprising: receive means for receiving a recording programming mail from the outside, the recording programming mail containing programming contents; and entering means for entering a recording programming in accordance with the programming contents obtained by the receive means, classified in class 709, subclass 217.
 - II. Claims 5-9, drawn to an information recording and playback apparatus comprising: a timer section which operates the information recording and playback section at a predetermined operation starting time, and stops the information recording and playback section at a predetermined operation ending time; a memory section which holds operation information of the timer section; a communications control section which inputs and sets at least the operation starting time and the operation ending time in the timer section from the outside, classified in class 386, subclass 95.
 - III. Claims 10-11, drawn to a method of controlling an information recording and playback apparatus, the method comprising: judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time

and the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively, classified in class 725, subclass 21.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because group I does not require "a timer section which operates the information recording and playback section at a predetermined operation starting time, and stops the information recording and playback section at a predetermined operation ending time; a memory section which holds operation information of the timer section; a communications control section which inputs and sets at least the operation starting time and the operation ending time in the timer section from the outside" of group II. The subcombination has separate utility such as "a timer section which operates the information recording and playback section

at a predetermined operation starting time, and stops the information recording and playback section at a predetermined operation ending time; a memory section which holds operation information of the timer section; a communications control section which inputs and sets at least the operation starting time and the operation ending time in the timer section from the outside".

3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I does not require "judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively" of group III. The subcombination has separate utility such as "judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and

the operation ending time included in the recording control information contained in the mail whose recording programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively”.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as “judging whether a recording programming is acceptable with the operating starting time and the operating ending time included in the mail judged to be a mail containing the recording control information, the operation starting time and the operation ending time included in the recording control information contained in the mail whose recording

programming has been judged acceptable, the operation starting time and the operation ending time serving as information used for controlling a timer section, the timer section operating and stopping an information recording and playback section at the operation starting time and the operation ending time, respectively". See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621
Daquan Zhao

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621